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PTO/SB/33 (01-09)
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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
STADELE=2

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on _____

Signature _____

Typed or printed name _____

| Application Number | Filed |
|---|---|
| 10/805,337 | 2004-03-22 |

First Named Inventor
Norbert STADELE

| Art Unit | Examiner |
|---|---|
| 1733 | B. J. Musser |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 31,979.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Ronni S. Jillions/
Signature

Ronni S. Jillions
Typed or printed name

202-628-5197
Telephone number

2009-02-25
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Atty. Docket: **STADELE-2**

| | | |
|---|---|---|
| In re Application of: Norbert STADELE | ) | Conf. No.: 9096 |
| | ) | Art Unit: 1733 |
| Appln. No.: 10/805,337 | ) | Examiner: MUSSER, BARBARA J. |
| Filed: March 22, 2004 | ) | Washington, D.C. |
| For: CORRUGATING MACHINE AND METHOD FOR THE ..... | ) | February 25, 2009 |

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Amendments
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Office Action of November 26, 2008, please amend as follows:

**Remarks/Arguments** begin on page 2 of this paper.

**REMARKS**

This is a request for review of the examiner's rejection of all of the claims of this application based upon clear error in facts and the omission of essential elements required to establish a prima facie rejection.

The latest action by the examiner states that claims 9, 11 and 12 are rejected under 35U.S.C.103 as being unpatentable over Alden (WO '541A1) in view of Welschlau (U.S. Pat. '898), Spann (U.S. Pat. '361) and Loffler (U.S. Pat. '746). Although it is not a final rejection, the claims have been twice rejected, therefore an appeal is timely.

The deficiencies of Alden, Welschlau and Spann are adequately set forth in the Request for Reconsideration of June 23, 2008. Specifically, Alden does not relate to "manufacture of corrugated board", see the Request for Reconsideration, the paragraph bridging pages 2-3, he does not recognize any shrinkage problems that may arise from the manufacturing process of corrugated board or how to solve the negative effects that shrinkage problems have on the printing process, nor does he suggest scaling of the printed images due to shrinking, see the paragraph beginning on page 3, line 7 of the Request for Reconsideration.

Welschlau was used by the examiner to make the process of Alden inline wherein "the corrugated board is formed and then printed and cut", see page 2, lines 16-20 of the rejection of Nov. 26, 2008. However, Welschlau is concerned with problems arising from non-alignment of the images when two images have to be superimposed on one another and how to solve those problems using marks on the carrier band, see the paragraph bridging pages 3-4 of the Request for Reconsideration.

On the other hand, Alden does neither discuss the need to form corrugated board, nor does he relate to printing on continuous, endless webs of material. Thus, one of ordinary skill in the art would not be motivated to combine Welschlau and Alden as set forth in the rejection, see the paragraph beginning on page 4 of the Request for Reconsideration. Also, there is no teaching as to how one would use digital printing in an inline process, since Welschlau uses carrier bands that are shifted relative to one another and rotary printing cylinders, see the paragraph bridging pages 4-5 and the paragraph beginning on line 14 of page 5 of the Request for Reconsideration. See also the inventor's declaration of December 3, 2007, numbered paragraph 5.

Spann was used in the rejection to show that an ink jet printer is considered a digital printer and therefore the printer of Alden is a digital printing process. However, Spann as well as Alden and Welschlau do not address the issue of shrinkage. Further, Spann is not concerned with manufacturing of corrugated board. Since Alden does not relate to "manufacture of corrugated board", it is not obvious from Alden to use a digital printer in a method for the manufacture of sheets of corrugated board. For such a process, a person skilled in the art has previously always used rotary printers, as is incidentally also confirmed by the state of the art cited by the examiner.

Loffler was used in the rejection to allege that it would have been obvious "to determine the shrinkage or expansion of the corrugated board by placing marks on the board and measuring their spacing downstream using a sensor to determine the change in the image size to modify the printing size upstream so that the final image is the desired size since Loffler discloses using marks to determine the amount of shrinkage or growth in the web so that the image can be altered to compensate for

changes in the size of the printed image", see the paragraph beginning on page 3 of the rejection.

However, Loffler neither relates to a method for the manufacture of corrugated board nor discloses a digital printer. Loffler relates to a sheet-fed offset printing machine that prints on individual sheets by printer 2 and feeds the sheets to the dryer 8. The sheet size in Loffler may change due to ink, dampening medium, forces of conveying, and the thermal field in the thermo-drying device 8, col. 3, lines 48-52. These changes are detected by image detectors 6, 7 before and after the drying station 8. These data are fed to a signal processing unit 16, which controls the temperature of the dryer and/or the speed of conveying the sheets, see the paragraph bridging cols. 4-5 of Loffler to ensure that the amount of contraction is reduced or remains constant during the entire print run, col. 4, lines 6-9 of Loffler.

The examiner states in the rejection, page 3, lines 7-9, that the "reference does not clearly disclose how this compensation occurs, but one in the art would appreciate that compensating for the change in size of the printed image *would require changing the size of the printing"* (emphasis added).

Loffler however does state explicitly what is being changed--it is the speed of conveying through the dryer or the drying temperature. The result of the change is to reduce the amount of change of shrinkage or to have it remain constant. The device of Loffler does not flexibly scale the size of the printed image by the printer inline to compensate for the shrinkage that occurs during the manufacturing process as specifically claimed in independent claims 9 and 12 because this is not possible with the offset printing machine according to Loffler. Although Loffler mentions that "the mean

coordinate-dependent changes of the dimensions may be taken into account when making the printing form" (column 2, lines 1 to 3), this clearly shows that the printing process by Loffler is not a digital one and is not suited for flexible scaling of the printing patterns in an inline process. Digitally printing the printing pattern on a web of corrugated board in accordance with the determined scaling factors is not possible with the printers disclosed by Loffler.

The examiner has used improper hindsight reconstruction to assert that one of ordinary skill in the art would compensate for shrinkage of the board (i.e. "change in size of the printed image") by changing the size of the printing. However, Loffler teaches away from this method of solving the problem. Instead, Loffler teaches one of ordinary skill to reduce or control the shrinkage that occurs. Thus, the asserted combination teaches away from the claimed invention.

For all of the above reasons the review should determine that the rejection of the claims is improper and the case should be allowed.

Respectfully submitted,

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